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EXAMINER

GOODMAN, CHARLES

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 07/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/422,758

Applicant(s)

PACKHAM ET AL.

Examiner

Charles Goodman

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 38-58 is/are pending in the application.
- 4a) Of the above claim(s) 20,21,40,41,44,45,48 and 49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19,38,39,42,43,46,47 and 50-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 29 April 2002 is: a) ☐ approved b) ☒ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. The Supplemental Amendment filed on April 29, 2002 has been entered.
2. The Amendment filed on January 14, 2002 has been entered.
3. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on April 29, 2002 have been disapproved because they introduce new matter into the drawings. 37 CFR 1.121(a)(6) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not support the showing of the features in the proposed amendment to Fig. 3. It is noted that with respect to the other proposed drawing corrections, these will be given favorable consideration if submitted separately.

### ***Continued Examination Under 37 CFR 1.114***

4. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 29, 2002 has been entered.

### ***Election/Restrictions***

5. Applicant's election without traverse of Group I, Species I, claims 1-19, 38, 39, 42, 43, 46, 47, and 50-53, in Paper No. 8 is acknowledged.

6. Claims 20, 21, 40, 41, 44, 45, 48, and 49 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected Groups and Species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 8.

### ***Drawings***

7. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "118" has been used to designate both a parabolic end skirt (Fig. 1) and an under cutter (Fig. 11); "243" has been used to designate both a cutaway of a mask (Fig. 26) and a foil aperture pattern (Fig. 27); "41" has been used to designate both a curved under cutter (Fig. 4) and a developer (Fig. 32); "42" has been used to designate by a drive arrangement (Fig. 4) and something that appears to be a stirrer (Fig. 32). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

8. The drawings are objected to because in Fig. 18, reference "61" should read -- 161 --. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

9. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the elongate hair-capture slots (e.g. claim 9) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

10. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: “121” (amendment to p. 9, l. 10 in Paper No. 17); “181” (amendment to p. 10, l. 32); “244” (amendment to p. 23, l. 1); “341” (amendment to p. 22, l. 19 in Paper No. 17). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 9, 15, and 57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- i. Claim 9 is vague and indefinite in that it is not clear what the claim encompasses. Where is the “elongate hair-capture slots” shown in the drawings? **The same applies to the rest of the claims.**

- ii. Claim 57 is vague and indefinite in that it is not clear what the claim encompasses. What is the "stress-free state" referring to? Moreover, what is "region" referring to? Perhaps the term should read -- region --?

***Claim Rejections - 35 USC § 102***

13. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
14. Claims 1-17, 50-54, 57, and 58 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Pranjko (DE M9004739.7). See Fig. 1.

***Claim Rejections - 35 USC § 103***

15. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
16. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

17. Claims 18, 19, 38, 39, 42, 43, 46, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pranjko (DE M9004739.7) in view of Packham (GB 2,036,631 A).

Pranjko discloses the invention substantially as claimed. Although Pranjko does not show an under cutter *per se*, it is the Examiner's position that Pranjko's depicted device would inherently include an under cutter that is oscillatory driven by a driving element due to the fact that the shaving system of Pranjko is a dry shaver with a curved skin engaging surface wherein during operation of the device, a cooperating under cutter is necessary to facilitate the shave. See whole document. However, if it is argued that Pranjko lacks the under cutter and drive element, then Packham clearly teaches a shaving system comprising a curved outer surface 8 which functions as an outer cutter, an under cutter 9 conforming to the outer cutter, and a drive element 4 that oscillates the under cutter for the purpose of providing the positive cutting action for drive shaver systems. See Fig. 2, p. 1, ll. 93-125. Thus, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the device of Pranjko with the under cutter and drive element as taught by Packham in order to facilitate positive cutting action of the dry shaver.

18. Claims 18, 19, 38, 39, 42, 43, 46, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pranjko (DE M9004739.7) in view of Furuichi (JP 405049760).

Pranjko discloses the invention substantially as claimed. Although Pranjko does not show an under cutter *per se*, it is the Examiner's position that Pranjko's depicted device would inherently include an under cutter that is oscillatory driven by a driving element due to the fact that the shaving system of Pranjko is a dry shaver with a curved

skin engaging surface wherein during operation of the device, a cooperating under cutter is necessary to facilitate the shave. See whole document. In that regard, Furuichi clearly teaches a shaving system comprising a curved outer surface 2 which functions as an outer cutter, an under cutter 3 conforming to the outer cutter, and a drive element e.g. 4 that oscillates the under cutter for the purpose of providing the positive cutting action for drive shaver systems. See whole document. Thus, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the device of Pranjko with the under cutter and drive element that conforms to the shape of the outer cutter as taught and suggested by Furuichi in order to facilitate positive cutting action of the dry shaver, and since with respect to the conforming shape, such a modification would have involved a mere change in the shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art, especially since such a change does not render unexpected or unobvious results. *In re Rose*, 105 USPQ 237 (CCPA 1955).

19. Claims 55-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pranjko (DE M9004739.7).

Pranjko discloses the invention substantially as claimed including what appears to be same material curved regions and end cheek regions. However, if it is argued that Pranjko lacks this feature, then it would have been obvious to the ordinary artisan at the time of the instant invention to provide the device of Pranjko with the same material regions in order to facilitate ease of manufacture due to the same material being used to produce the same, since it has been held to be within the general skill of a worker in the

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art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

### ***Double Patenting***

20. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

21. Claims 1-7, 16, 17, 57, and 58 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. Des. 430,352. This is a double patenting rejection.

22. Claims 1-7, 10-13, 16, 17, 50-54, 57, and 58 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. Des. 428,671. This is a double patenting rejection.

### ***Response to Arguments***

23. Applicant's arguments filed January 14, 2002 and April 29, 2002 have been fully considered but they are not persuasive.

In response to Applicant's basic argument that Pranjko does not anticipate the claimed invention of claims 1, 16, and 17 because it is allegedly a design patent with no

written description,<sup>1</sup> this argument lacks merit. First, the Examiner's previous comments on this issue in the last Office Action applies here.<sup>2</sup> Second, as stated before, it is irrelevant whether or not Pranjko includes a written description of the structure since comparison of the Figures in Pranjko with that of Applicant's Figs. 1-3 clearly show that Pranjko anticipates the claimed shape of the structure. Third, with respect to Applicant's assertion of the Examiner taking the position of "inherency", this argument is wanting considering that the Examiner has no need to take this position in view of Pranjko's Figures. It is not only the alleged "grill" that the Examiner relies in rejecting the claims. It is also the whole shaving head region including the what Applicant's refer to as the "convex elliptic end cheeks" and "parabolic end skirts". Assuming *arguendo* that the Examiner was taking the "inherency" route, the Examiner fully meets the burden that the Applicant notes in the various citations because of the simple fact that although Pranjko is a design publication, the invention shown therein is a dry shaver clearly showing the claimed shape with the so called "grill" anticipating the claimed "perforations" which is well known to the ordinary artisan in the shaving art as one of the basic components of a dry shaver for facilitating insertion of the hair to be shaved by an under cutter inherent in dry shavers. Thus, this clearly meets the two conditions, i.e. (1) the feature asserted to be "inherent" must be "necessarily present in the thing described in the reference and (2) that it would be so recognized persons of ordinary skill. *Robertson*, 49 USPQ.2d at 1950-51; same *Electro Medical Sys.*, 32 USPQ.2d at 1020. Fourth, Applicant's reliance on MPEP §2125 is also unavailing due to the fact that

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<sup>1</sup> See Amendment C, Paper No. 17, p. 4, l. 1 - p. 6, l. 19.

no improper inferences have been made with respect to the drawings, and in this case, there are no exceptional circumstances with respect to the claimed features such that “caution” and considerations of “scale” are necessary.

In response to Applicant’s basic argument predicated on the allegation of “non enablement” of Pranjko,<sup>3</sup> this argument wholly lacks merit. First, the method of forming (or fabricating) the device is not germane to the issue of patentability of the device itself. Therefore, any limitations directed toward how the device is fabricated will not be given patentable weight. It is emphasized that the claims at issue are directed toward the apparatus, i.e. the structure of the shaving cutter, NOT toward a method of making or forming or fabricating the apparatus. Second, even without a written disclosure in Pranjko, one of ordinary skill in the shaving art would be able to fabricate the shaver depicted in Pranjko without undue experimentation since that ordinarily skilled artisan would have the knowledge and skill to shape the common materials used in manufacturing such shavers and foils using, e.g., molding, stamping, or photoelectric processes.<sup>4</sup> The above applies to ALL of Applicant’s assertions relating to how Pranjko’s device is made.

In response to Applicant’s basic argument that Pranjko does not anticipate claims 5, 6, and 10,<sup>5</sup> this argument lacks merit. The term “region” is broad. As such, these limitations have been correctly read in a reasonably broad manner with respect to Pranjko. In that regard, the regions below and surrounding the “grill” anticipates these

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<sup>2</sup> See Final Office Action, Paper No. 14, p. 6, ¶ 19 and compare Applicant’s arguments in Amendment B, paper No. 13, p. 6, l. 16 - p. 7, l. 8.

<sup>3</sup> Amendment C, p. 6, l. 20 - p. 10, l. 6.

<sup>4</sup> Note, e.g., the teachings of Otsuka et al ‘818 (US 5,473,818) with regards to Figs. 19-25.

<sup>5</sup> Amendment C, p. 10, l. 7 - p. 13, l. 18.

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limitations. Moreover, it is not clear how Pranjko lacks these regions. Pranjko's Figures clearly show concave parabolic, convex parabolic, convex elliptic, etc. areas. It is also noted that Pranjko's depiction shows a "banana shape" as referred to in the application disclosure (e.g. p. 7, ll. 22-24). Thus, to what extent must these regions/areas be to *not* anticipate the claims? The claims do not say. Therefore, Applicant's arguments utterly fails.

In response to Applicant's basic argument that Pranjko and Packham do not render obvious the claimed invention, this argument lacks merit. It is a well known basic and wholly obvious fact to the ordinary artisan in the shaving art that the device depicted in Pranjko is a dry shaver. It is also a well known obvious fact to the ordinary artisan in the shaving art that the dry shaver must include an under cutter to cooperate with the foil (or the "grill" as Applicant refers) to cut hairs that insert into the holes on the foil. Therefore, while the Examiner acknowledges that a variety of under cutter designs may be available in the art, the fact remains that Pranjko must necessarily include one in an operating device. Hence, Pranjko provides a *prima facie* case of obviousness for an under cutter for which Packham clearly teaches and renders obvious the claims. Moreover, with regard to the "conforming shape" of the under cutter, Packham clearly teaches that the shape of the under cutter conforms to the shape of the outer cutter. Due to this fact, it is obvious to the ordinarily skilled artisan in the shaving art that the Examiner's proposed modification would also necessarily include conformance of the under cutter taught and suggested by Packham to that of the outer cutter depicted in Pranjko. Furthermore, in response to Applicant's assertion that the so called "mismatch" would somehow preclude the combination, i.e. difficulty in

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incorporating the teachings of the secondary reference, Applicant is reminded that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to Applicant's arguments with respect to claims 54-56,<sup>6</sup> these arguments lack merit. First, Applicant's assumption with respect to claim 54 is patently incorrect. Claim 54 merely calls for the surface and the cheeks to be integrally formed. As such, it is abundantly clear to the ordinary skilled artisan in the shaving art that in *Pranjko*, the surface and the cheeks must have been formed in some manner - note that it is irrelevant how, i.e. methods of fabricating, these features are formed - and that they are integral. Therefore, claim 54 is anticipated. Second, due to the inherent fact that the device depicted by *Pranjko* must be made of some sort of material, the claimed materials in claims 55-56 are obvious. Applicant fails to address this issue on point. Thus, Applicant's argument fails on this issue.

In response to Applicant's argument that *Pranjko* does not anticipate claim 57,<sup>7</sup> this argument lacks merit. First, the claim is indefinite. Second, even if the claim is not, *Pranjko* still anticipates this claim because there is no stress acting on the device depicted in *Pranjko*.

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<sup>6</sup> *Id.*, p. 13, ll. 19-27.

<sup>7</sup> *Id.*, p. 14, ll. 1-10.

In response to Applicant's basic argument traversing a potential double patenting rejection,<sup>8</sup> this argument lacks merit. First, MPEP §1504.06 (II) deals with nonstatutory double patenting rejections in design-utility situations. That's not the issue here. The issue is a statutory one wherein the claimed invention is not patentably distinct from the design patents and both the current application and the design patents have the same inventive entity.

### ***Conclusion***

24. Packham et al '317, Sagawa et al, Cornwell et al Jr. et al, Jepson et al, and Cobarg et al are cited as additional pertinent art.

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Goodman whose telephone number is (703) 308-0501. The examiner can normally be reached on Monday-Thursday between 7:30 AM to 6:00 PM EST.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap, can be reached on (703) 308-1082.


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<sup>8</sup> Amendment D, Paper No. 21, p. 2, l. 7 - p. 3, l. 3.

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In lieu of mailing, it is encouraged that all formal responses be faxed to 703-872-9302. Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-1148.

cg   
July 12, 2002

  
**Charles Goodman**  
**Primary Examiner**  
**AU 3724**

**CHARLES GOODMAN**  
**PRIMARY EXAMINER**